

REMARKS

I. STATUS AND AMENDMENTS

A. Response to Final Office Action and ensuing Advisory Action

Applicant received the Final Office Action dated December 13, 2007, in which the Examiner rejected claims 1-11 and 15-20 under 35 U.S.C. § 101 as allegedly inoperable and lacking utility. Upon receiving this Final Office Action, the undersigned conducted a telephone interview with Primary Examiner Samuel Rimmell. Primary Examiner Rimmell provided the undersigned with suggested claim amendments that would virtually ensure allowance of the case.¹ Accordingly, Applicant promptly prepared and filed a Response to Final Office Action that included the amendments suggested by Primary Examiner Rimmell. Unfortunately, new Examiner Al-Hashemi refused to allow the amendments suggested by Primary Examiner Rimmell, stating that the new amendments “raise new issues [that] require further search and/or consideration.”

B. Advisory Action Refusing Entry of Amendments Prolongs Prosecution

Applicant disagrees with Examiner Al-Hashemi's rationale. The only outstanding rejection in the Final Office Action was a 35 U.S.C. § 101 rejection. Both Applicant and Primary Examiner Rimmell agreed that Examiner Rimmell's suggested amendments were sufficient to overcome this § 101 rejection and to place the case in condition for allowance. Contrary to Examiner Al-Hashemi's assertion, no further search would be required, because Applicant's amendments did not introduce new material to the claims; the amendments merely re-phrased the existing claim limitations to conform with 35 U.S.C. § 101. Thus, Applicant very respectfully submits that Examiner Al-Hashemi may have hastily prolonged prosecution in a case that was and still is ready to be allowed.

C. Preliminary Amendment Overcomes All Rejections

However, Applicant desires to fully comply with new Examiner Al-Hashemi and to bring this case to a quick and timely resolution. Thus, Applicant hereby submits this Preliminary Amendment, along with a Request for Continued Examination (RCE), requesting entry of the same amendments Applicant

¹ A Summary of the Interview is of record.

submitted in the Response to Final Office Action. Applicant respectfully requests that Examiner Al-Hashemi recognize that the pending claims have been thoroughly examined by Primary Examiner Rimmell and found to be allowable over all prior art; that the pending claims only have a 35 U.S.C. § 101 rejection outstanding against them; and that the amendments agreed upon by Primary Examiner Rimmell and Applicant are sufficient to overcome the § 101 rejection imposed by Examiner Rimmell.

II. REJECTIONS UNDER 35 U.S.C. § 101

Claims 1-11 and 15-20 stand rejected under 35 U.S.C. § 101.

A. Claims 1-6 and 19

In reference to claim 1, the Final Office Action stated:

The term “software” is broad enough to encompass any and all possible software, and the vast majority of all possible software will not cause a workstation to be re-configured to function as a server. Accordingly, the claim recites the impossible condition of having any possible software causing a workstation to be re-configured as a server, and thus is inoperable for reciting any impossible condition.

Applicant disagrees with Examiner Rimmell’s contention that the term “software,” as used in claim 1, is “broad enough to encompass any and all software... .” To the contrary, the term “software” in claim 1 was already limited to only the type of software that “is provided from the file system to the workstation via the file server so that the workstation is re-configured as a server that provides said services to the client computer.”

However, in the interest of a speedy resolution to this case, Applicant cooperated with the Patent Office by amending claim 1 in the Response to Final Office Action to require “wherein, in response to a request from the client computer, a software element for reconfiguring a workstation into a server is provided from the file system to the workstation via the file server so that the workstation is re-configured as a server that provides said services to the client computer,” as suggested by Examiner Rimmell. This amendment clearly defines and limits the term “software,” thereby eliminating Examiner Rimmell’s concern that the recited software is “broad enough to encompass any and all software... .” Thus, Applicant very kindly requests that Examiner Al-Hashemi withdraw this

rejection. Because the § 101 rejection against claim 1 should be withdrawn, the § 101 rejections against dependent claims 2-6 and 19 also should be withdrawn.

B. Claims 7-11 and 20

In reference to claim 7, the Final Office Action stated:

This claim is inoperable for two separate reasons: (1) The claim does not have a mandatory requirement to transfer the re-configuring application to the workstation. Lacking any transfer of applications to the workstation, the re-configuring would never take place. (2) The term “client application” is broad enough to encompass any and all possible client applications, and the vast majority of all possible client applications will not cause a workstation to be re-configured to function as a server.

Again, Applicant disagreed with Examiner Rimmell’s rationale, but fully cooperated with the Patent Office by amending claim 7 to comply with Examiner Rimmell’s suggestions. As amended, claim 7 requires “a file system that is adapted to store client applications including at least one client application for reconfiguring a workstation as a server” and “wherein the workstation is configured such that client applications are transferred to the workstation from the file system via at least one of the file servers when requested by the client computer so that the workstation is re-configured as a server.” These amendments eliminate Examiner Rimmell’s concerns. First, as amended, claim 7 has “a mandatory requirement to transfer the re-configuring application to the workstation.” Second, as amended, claim 7 defines “client application” narrowly enough so that it is no longer “broad enough to encompass any and all possible client applications.” Thus, all 35 U.S.C. §101 rejections against claims 7-11 and 20 should be withdrawn.

C. Claims 15-16

The Final Office Action rejected claims 7 and 15 for similar reasons. As amended, claim 15 now requires “means for storing client applications including at least one client application for reconfiguring a workstation as a server,” “second means for executing software, the second means for executing reconfigurable by said client application for reconfiguring,” and “means for transferring said client application for reconfiguring from the means for storing the client applications to said second means for executing software via the first means for executing

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software, so that the second means for executing software is re-configured as a server that provides said service to a client computer.” Just as the amendments to claim 7 overcome the 35 U.S.C. § 101 rejections against claims 7-11 and 20, the amendments to claim 15 overcome the 35 U.S.C. § 101 rejections against claims 15-16. Thus, the § 101 rejections against claims 15-16 should be withdrawn.

D. Claims 17-18

The Final Office Action rejected claims 1 and 17 for similar reasons. Although Applicant disagrees with Examiner Rimmell’s rationale, Applicant complies with the Patent Office by amending claim 17. As amended, claim 17 now requires “wherein said CPU requests and obtains a client application for reconfiguring the workstation as a server from an external file system via a file server on behalf of a client so that the workstation is re-configured as a server.” Just as such an amendment was sufficient to overcome the 35 U.S.C. § 101 rejection against claims 1-6 and 19, this amendment is sufficient to overcome the § 101 rejections against claims 17-18. Thus, the § 101 rejections against claims 17-18 should be withdrawn.

III. CONCLUSION

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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